

Ser. No. 10/072,698
Reply to Office Action of 4 June 2003
Atty Docket 117163-38

REMARKS

Claims

Claims 1-8 and 17-46 were pending in this matter on the date of the Office Action. No claim amendments are made at this time, so no listing of the claims as they presently stand is provided.

Finality of the Rejection

Although the Examiner has made this action a final rejection of the claims, applicant respectfully requests reconsideration and withdrawal of the finality, on the basis that the Examiner has erred in that matter. Specifically, according to MPEP §706.07(a), states in relevant portion:

"Furthermore, a second or subsequent action on the merits will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement ..., of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art."

In the Office Action mailed 7 November 2002, the Examiner rejected claim 1 and claim 10, inter alia, as anticipated by Amundson '346. In the response mailed 6 March 2003, the applicant amended claim 1 by incorporating the limitation of claim 10 and cancelled claim 10. Accordingly, claim 1, as it now stands, is an independent form of prior claim 10. The applicant clearly pointed out that the limitation added from claim 10 into claim 1 is not present in Amundson '346. The Examiner has apparently agreed with this, because the Examiner does not continue the rejection of claim 1 based on Amundson '346 under 35 USC §102. Further, the Examiner has clearly stated, in the §103 rejection based on the combination of Amundson '346 and a newly-cited reference (US Patent 5,643,197 to Brucker) ("Brucker '197"), that Brucker '197 provides the missing element of "an electrode adapted for one of delivering/receiving an electrical signal." Claim 1, viewed as an independent form of claim 10 was "not amended by applicant." Applicant has not had a fair opportunity to address Brucker '197, which should have been cited by the Examiner relevant to claim 10 in the prior action, if the combination is correct now.

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Further, the Examiner has also now rejected claims as being obvious over a combination of Stelzer '345 in combination with Brucker '197. As with Amundson '346, the Stelzer '345 reference was previously used as a basis for a 102(b) rejection of claim 10. The Examiner has erred in not providing applicant with a fair opportunity to address this combination.

For these reasons, applicant insists that the finality of the rejection is improper and should be withdrawn.

35 USC §103 Rejections

Claims 1, 6, 18, 22, 26, 30, 34, 38 and 42 are rejected as being obvious over the combination of either Amundson '346 or Stelzer '345 with Brucker '197. The Examiner's analysis in each case is basically the same: either Amundson '346 or Stelzer '345 fails to teach an electrode adapted to at least deliver or receive an electric signal, as required by claim 1. For this limitation, the Examiner posits that Brucker '197 provides such an electrode.

Applicants respectfully submit that the Examiner's position is incorrect in combining either Amundson '346 or Stelzer '345 with Brucker '197.

In creating a combination of prior art references, the Examiner needs to make a prima facie case that the person of ordinary skill, seeking to solve an unsolved problem of the prior art, would be led from the teaching of a first piece of the prior art to a second piece, thereby establishing the nexus between the references. For that reason, the Examiner needs to consider the stated intention of the present invention. For that, the applicants direct the Examiner's attention to paragraph [0006] of the present application, which states:

Preferably the endoscopic catheter is in the form of an electrode line and for that purpose is provided at its distal catheter portion with at least one electrode for delivering and/or picking up electrical signals to or from body tissue adjoining the distal catheter portion. A catheter of that kind, which for example is provided with stimulation electrodes, can advantageously be optically controlled to move to its target location.

Amundson '346 and Stelzer '345 each show optical catheters, but the Examiner admits that they lack the signal electrode. To find the signal electrode, the Examiner selects Brucker '197. The applicants acknowledge that the Examiner is correct in asserting that Brucker '197 teaches the

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use of the catheter tip electrode 26 as a "monitoring means" (Col. 3, lines 31-33, 40-42 and 48-49). The Examiner also relies upon Brucker '197 at Col. 9, line 66 through Col. 10, line 6 as teaching the use of a catheter tip electrode 26 in a catheter body 22 with a central lumen 28 that can receive a separate device 42, which can include "an endoscope for direct viewing of the biological material in the vicinity of the distal tip of the catheter." If the Examiner is correct, then, Figure 1 of Brucker '197 operates as a 102(b) reference by itself, because it shows the optical viewing capability for which the Examiner also relies upon Amundson '346 or Stelzer '345. But the reason why Brucker '197 is not a good 102(b) reference is the same reason why it cannot be properly combined with Amundson '346 or Stelzer '345 – it doesn't work in combination and Figure 1 is not enabling for what the specification teaches. There is simply no embodiment taught in Brucker '197 of a catheter tip electrode, particularly one that could serve as an ablation electrode, through which an optical endoscope could view the tissue in the vicinity of the tip. Note, for example, the optical lens 54 shown at the catheter tip of Figure 2 of the present application, which is described at paragraph [0014]. Contrast this optical lens with the description at Brucker '197, Col. 6, lines 1-40, where a sintered metal catheter tip structure is taught. This metal structure is particularly needed, as stated at lines 44-45, for it has "the ability to monitor and measure electrical potentials of a tissue."

In view of the foregoing arguments the applicant submits that the claims are in a condition to permit allowance. Therefore the applicant requests early and favorable disposition of this application.

Respectfully submitted,



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